

## REMARKS

1. Claims 1-4, 6, 7, 9, 13-15, and 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wortham in view of Withers. Wortham teaches a transparent flexible plastic bag (15), with an opening (17), applied to a transparent container (11). The container is used to dispose of stoppered test tubes containing body fluids. The bag has a reinforced opening (17 and 18 on Figure 2) in the wall [of the bag] through which the stoppered end of a test tube may be inserted. The stopper is then removed by grasping it from outside the bag and dropping it into the container. (Abstract). Withers teaches another type of container providing intersecting slits (47) in order to dispose of used medical syringes, and which furthermore prevents unwanted removal of the disposed contents.

Claim 1 has been amended to clarify, what was said in different words originally, that the closure is a plastic tube and not a bag as in Wortham. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Neither Wortham nor Withers teach or suggest a piece of plastic tubing with slits to form the closure for a container.

Further, modifying Wortham to use plastic tube in place of a bag would make the modified Wortham unsuitable for its intended purpose, i.e., to dispose of stoppered test tubes. In Wortham, the stopper is removed from the test tube by grasping it from outside the bag and dropping it into the container. This works well with a plastic bag, however tubing would not allow a user to grasp the test tube stopper from outside of the tubing to remove the stopper. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

It is therefore respectfully requested that the rejection of Claims 1-4, 6, 7, 9, 13-15, and 17-19 as amended, be reconsidered and the claims allowed.

Claims 8 and 10-12 were rejected over Wortham in view of Withers in further view of Lovelace. Lovelace teaches a glass container having neck threading. Neither Wortham, Withers nor Lovelace teach or suggest plastic tubing with slits therein to form the closure for a container. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Wortham has a plastic bag instead of plastic tubing. Modifying Wortham to use plastic tube in place of a bag would make the modified Wortham unsuitable for its intended purpose, i.e., to dispose of stoppered test tubes. In Wortham, the stopper is removed from the test tube by grasping it from outside the bag and dropping it into the container. This works well with a plastic bag, however tubing would not allow a user to grasp the test tube stopper from outside of the tubing to remove the stopper. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

It is therefore respectfully requested that the rejection of Claims 8 and 10-12 as amended, be reconsidered and the claims allowed.

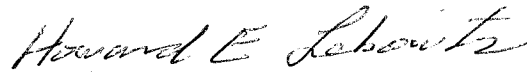
Claims 5 and 16 were rejected over Wortham in view of Withers in view of Bordage. Bordage teaches a means for hanging a tube, comprising a hole in the tube and a loop secured therethrough. Neither Wortham, Withers, Lovelace nor Bordage teach or suggest plastic tubing with slits therein to form the closure for a container. To establish *prima facie* obviousness of a claimed invention, all the

claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

It is therefore respectfully requested that the rejection of Claims 5 and 16 as amended, be reconsidered and the claims allowed.

Applicant believes that claims 1-19 as amended are now in condition for allowance, and respectfully requests a timely Notice of Allowance.

Respectfully Submitted,

A handwritten signature in cursive script that reads "Howard E. Lebowitz".

Foothill Law Group, LLP.  
Howard E. Lebowitz  
Attorney for the Applicant  
Reg. Number 44864  
510-785-8070